

Remarks/Arguments:

Claims 1-4 and 8-17 were pending. Claims 4, 8-15, and 17 were allowed.

Claims 1-3 and 16 were rejected under 35 USC 112, first paragraph, as failing to comply with the written description requirement, because "there is no support for the specific data point of 12%". Applicants point out that with respect to changing numerical ranges, the decision of in re Wertheim, 541 F.2d 257, 191 USPQ 90 (CCPA 1976) supports the position that an originally disclosed range provides written description requirement support for amended claims with narrower ranges. One skilled in the art would recognize that the subject matter of claim 1 is described in the specification including the claims as filed so as to reasonably convey that the inventors had possession of the claimed invention. The following is a quotation from MPEP 2163.04:

In the Wertheim case, the issue was whether the foreign priority document complied with the description requirement of 35 U.S.C. 112, first paragraph as to the claimed subject matter so that the application would be entitled to the benefit of the foreign filing date under 35 U.S.C. 119. The examiner met the burden of proof with respect to some claims, but not others. The foreign priority document disclosed a range of "25 to 60%" and specific examples of "36%" and "50%." A claim limitation of "at least 35%" did not meet the description requirement because the phrase "at least" had no upper limit and caused the claim to read literally on embodiments outside the "25% to 60%" range. However the court held a limitation to "between 35% and 60%" did meet the description requirement because "persons skilled in the art would consider processes employing a 35-60% solids content range to be part of appellants' invention. . . . The PTO has done nothing more than to argue lack of literal support, which is not enough" to support a rejection under 35 U.S.C. 112, first paragraph. 191 USPQ at 98.


The specification was objected to as failing to provide proper antecedent basis for the claimed subject matter because the acid content not having an upper limit as in claim 1 and claim 3 is not taught in the specification. The specification has been amended to teach this limitation.

Claim 1 was rejected under 35 USC 103(a) as being unpatentable over Dahayanake (actually Dahanayake) (US 6,258,859). Applicants declare that the disqualified subject matter and the claimed invention were made by or on the behalf of parties to a joint research agreement within the meaning of 35 U.S.C. 103(c)(3), that the joint research agreement was in effect on or before the claimed invention was made, and that the claimed invention was made as a result of activities undertaken within the scope of the joint research agreement.

In light of the above amendments and remarks, Applicants respectfully request that a timely Notice of Allowance be issued in this case.

The Commissioner is authorized to charge any additional required fee, or credit any excess fee paid, to Deposit Account 04-1579 (56.0630).

Respectfully submitted,



Thomas O. Mitchell
Agent for Applicants
Reg. No. 47,800

Date: May 9, 2006
Schlumberger Technology Corporation
110 Schlumberger Drive, MD-1
Sugar Land, Texas 77478
Ph: (281) 285-4490
Fax: (281) 285-8569